

REMARKS/ARGUMENTS

Claim 49 is pending in the present application. Claims 1-48 were canceled and claim 49 is amended. Applicant notes that although the claims are modified, Applicant does not surrender the subject matter of prior versions of the claims nor any subject matter disclosed in the Application. Support for the amendments to claim 49 may be found at least in the following portions of the Application which do not limit the subject matter of the claims: Paragraphs [0038], [0044], [0045] and FIG. 10.

I. 35 U.S.C. § 101

Claim 49 stands rejected under 35 U.S.C. § 101 allegedly because the claimed invention is directed to non-statutory subject matter. Office Action pp. 1-2. The Examiner alleges claim 49 was directed to a per se data transformation. As amended, claim 49 recites “creating a new return on investment template” and, as such, produces a tangible result, specifically “a new return on investment template.” Therefore, Applicant respectfully requests that the rejection be withdrawn.

II. 35 U.S.C. § 102, Anticipation

Claim 49 stands rejected under 35 U.S.C. § 102(e) over U.S. Patent Application Publication No. 2004/0064269 (herein Shibuya). Office Action pp. 2-5. “A claim is anticipated only if each and every element as set forth in the claim is found, either expressly or inherently described, in a single prior art reference.” *Verdegaal Bros. v. Union Oil Co. of California*, 814 F.2d 628, 631, 2 USPQ2d 1051, 1053 (Fed. Cir. 1987).

Claim 1 recites “the new return on investment template calculating an amount of money a customer will spend for a process upgrade.” These limitations were not addressed by the Examiner in the Office Action and Shibuya fails to teach these limitations at least because Shibuya is silent to its templates “calculating an amount of money a customer will spend for a process upgrade.” Rather, Shibuya’s templates are geometric template pattern images for identifying ring and blob type regional defects of a semiconductor wafer. Shibuya Abstract and [0067]. Hence, the cited art fails to teach the claim’s limitations of “the new return on investment template calculating an amount of money a customer will spend for a process upgrade,” as set forth in the claim.

Claim 1 also recites “the histogram comprising an orthogonal axis for each parameter in the default template.” These limitations were not addressed by the Examiner in the Office Action and Shibuya fails to teach these limitations at least because Shibuya is silent to its histogram “comprising an orthogonal axis for each parameter in the default template.” Hence, the cited art fails to teach the claim’s

limitations of “the histogram comprising an orthogonal axis for each parameter in the default template,” as set forth in the claim.

Claim 1 also recites “wherein the effectiveness factor of a template is based at least upon the accuracy of the applications in the template, the accuracy of the computers in the template, the accuracy of the customer’s information technology infrastructure, and whether the customer made a purchase.” The Examiner alleges Shibuya’s matching score meets the claim’s effectiveness factor. Office Action pp. 2-3. Shibuya fails to teach these limitations at least because Shibuya is silent to its matching score being “based at least upon the accuracy of the applications in the template, the accuracy of the computers in the template, the accuracy of the customer’s information technology infrastructure, and whether the customer made a purchase.” Rather, Shibuya’s matching score is merely based on whether template pattern image matches a high density area image of a semiconductor wafer. Shibuya Abstract and [0080]. Hence, the cited art fails to teach the claim’s limitations of “wherein the effectiveness factor of a template is based at least upon the accuracy of the applications in the template, the accuracy of the computers in the template, the accuracy of the customer’s information technology infrastructure, and whether the customer made a purchase,” as set forth in the claim.

Thus, the cited art fails to teach each and every element as set forth in the claim. Therefore, Applicant respectfully requests that the rejection be withdrawn.

III. Conclusion

It is respectfully urged that the subject application is patentable over Shibuya and is now in condition for allowance.

The Examiner is invited to call the undersigned at the below-listed telephone number if in the opinion of the Examiner such a telephone conference would expedite or aid the prosecution and examination of this application.

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Respectfully submitted,

/Rudolf O. Siegesmund/

Rudolf O. Siegesmund
Reg. No. 37,720
Yee & Associates, P.C.
P.O. Box 802333
Dallas, TX 75380
(972) 385-8777
Attorney for Applicants